REMARKS

This paper responds to the Final Office Action dated March 22, 2007. A diligent effort has been made to respond to the objections and rejections set forth in the office action, and reconsideration is respectfully requested. The Amendment should be admitted under 37 C.F.R. § 1.116(b) because: (1) it merely eliminates certain claim language found objectionable under 35 U.S.C. § 112; and (2) it thereby presents the only independent claim in better form for an appeal by minimizing the remaining issues in the case. Admission of this amendment is therefore respectfully requested.

1.   Status of Claims

Claims 1-28 were previously cancelled. Claim 29 is currently amended to remove the section 112 objection raised in the Final Office Action. Claims 30-38 remain in the application.

2.   Rejection under 35 U.S.C. § 112

The Examiner rejected claims 29-38 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. Specifically, the Examiner identified certain language at the end of claim 29 as being objectionable. Although Applicant specifically traverses the merits of this rejection, the language has now been removed from the claim and thus the 112 rejection should be withdrawn. Specifically, the claim now reads "until the presence server observes the state of the messaging client by receiving presence data from the messaging client, indicating that the messaging client has returned to the first known state." Support for this claim language is set forth in the application as filed, for example at page 14, line 10 through page 15, line 2; and also at page 16, line 13 through page 17, line 6; and also at page 15, line 15 through page 16, line 7.

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3. Rejection under 35 U.S.C. § 103

The "obviousness" rejection of claims 29-38 under 35 U.S.C. § 103 set forth in paragraphs 1 and 2 of the Final Office Action must be withdrawn (or at a minimum clarified in response to this Amendment under 37 C.F.R. § 1.116(b)) because the rejection mixes the obviousness analysis with an anticipation analysis, and therefore does not make any sense. Applicants cannot determine how to effectively respond to this rejection because it is unclear whether it is being made under 35 U.S.C. § 103 ("obviousness") or under 35 U.S.C. § 102 ("anticipation"), or perhaps it is being made under both sections. Therefore, withdrawal or clarification is respectfully requested.

Specifically, in paragraph 1 of the Final Office Action it is stated that "Claims 29-30, 32-28 are rejected under **35 U.S.C. 103(a) as being anticipated** by Agrawal (US Pub. No. 2002/0083127) in view of Dorencosch (US Pub No. 2002/0173308)." (emphasis supplied) Although at first glance this might appear to be a typographical error in that the Examiner meant to say "35 U.S.C. 103(a) as being obvious" instead of "35 U.S.C. 103(a) as being anticipated," later in paragraph 2 of the Final Office Action the Examiner appears to be making an anticipation rejection solely in view of Agrawal.

Paragraph 2 of the Final Office Action is very difficult to interpret. The Examiner begins paragraph 2 by comparing claim 29 to Agrawal, generally, and concludes that Agrawal meets the preamble limitation of the claim by reference to paragraph [0025] of the patent. Then, the Examiner compares the "receiving communications" step of claim 29 to Agrawal and asserts that this step is taught in paragraphs [0024], [0050-0052], and [0053] of the patent. The Examiner fails to show any kind of "state table entry" in the Agrawal reference, but instead merely asserts,

without any support, that it would be "inherent" in the patent. Following this analysis, the Examiner compares the "periodically transmitting" step of claim 29 to Agrawal and asserts that this step is taught in paragraphs [0025] and [0041, 0052] of the patent. Finally, regarding the last step of claim 29, the "if then. . . modifying the state table entry. . . , and thereafter inhibiting" step of the claim, the Examiner refers to paragraphs [0052], [0048], [0051] and [0044] of Agrawal in support of his assertion that this step is met. Thus, it would appear from this analysis that the Examiner is claiming that Agrawal <u>anticipates</u> claim 29.

But in making this apparent anticipation rejection, the Examiner admits that Agrawal does not teach that the "presence state data" is inhibited as a result of not receiving any communications from a messaging client during a predetermined period of time as required by this final step of claim 29: "Although Agrawal does not specifically teach that the data is presence data, he does teach that time sensitive data being delivered to unavailable clients should not be delivered ([0048])." The Examiner then asserts that presence data is a type of time sensitive data, with no support from any reference, and then concludes that "[T]herefore it would have been obvious for one skill in the art at the time of the invention to modify Agrawal's teaching to inhibit not only regular data delivery but also time sensitive data such as presence data delivery because it saves network resources to not deliver data to people who are not around to receive the data." In view of this statement, then, it appears that the Examiner is making a 103 (obviousness) rejection over just the Agrawal reference.

Further confusing matters, however, the Examiner then brings in the Dorencosch reference in the same paragraph of the Final Office Action, concluding that "it would have been obvious for one of ordinary skill in the art at the time of the invention to combine Agrawal's teaching of modifying the presence status of a client when there's lack of communications along
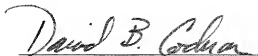
with Agrawal's suggestion of stopping time-sensitive data delivery to unavailable clients which is further supported by Dorencosch's teaching of discarding data or any kind of data delivery to the client when there's lack of client's communication because this would obviously reduce the amount of wasteful radio resource usage in sending data to an unreachable client." Here again, it is not clear exactly what kind of rejection is being made here: is it a 102 (anticipation) rejection over Agrawal? is it a 103 (obviousness) rejection over just Agrawal? or is it a 103 (obviousness) rejection over Agrawal in view of Dorencosch. The rejection is simply not understandable in its current form and therefore should either be withdrawn or clarified in view of this response.

Finally, applicant notes that the Examiner's admission that Agrawal does not specifically teach inhibiting the transmission of presence state data is fatal to this rejection, in whatever form it may ultimately take. Claim 29 is specifically directed to transmitting instant messages "and presence state data" between a plurality of messaging clients. There is no question that Dorencosch is silent on this point, and the Examiner has not attempted to assert as much. Thus, because the Examiner has admitted that Agrawal does not teach this step, there is no basis for maintaining the current rejection under either 35 U.S.C. § 102 or 103, and therefore on this additional basis the Applicant maintains that the rejection is faulty and should be withdrawn.

Claims 29-38 are in condition for allowance.

Respectfully submitted,

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